Remarks

Amendments to the Claims

Claims 2, 4, 7-8, 20-27, 30, 32-33, 35-36, 38-41 and 43-49 have been amended wherein the phrase "by weight of said . . . agent" has been replaced with the term "wt %" referring to percentage as measured by weight. Support can be found in the original language and examples in the specification. No new matter has been added.

§112 ¶2 Rejection

Claims 2, 3, 20-27, 30, 32, 33, 35 and 36 were rejected under 35 U.S.C. 112 ¶2 as "being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Applicants respectfully traverse. The Examiner believes that since claim 2 recites "wherein said dispersing agent comprises from about 20 to about 70 percent by weight of said dispersing agent . . ." that it is confusing since the comparison of percentages is with the same agent rather than the weight of the agent compared to the total weight of the dosage form. Applicants respectfully noted that the Examiner only cited a portion of the claim language and omitted "based on the total weight of said dosage form." Thus the entire phrase in claim 2 reads, "wherein said dispersing agent comprises from about 20 to about 70 percent *based on the total weight of said dosage form.*" *(emphasis added)* Applicants maintain that the language of claim 2 in its entirety (and other claims adopting the same language) particularly point out the claimed subject matter to one skilled in the art of pharmaceutics. One skilled in the art would know that the phrase "by weight of said dispersing agent" is meant to indicate that the percentage is based on weight not volume. Nevertheless, in an effort to expedite prosecution, Applicants have removed "by weight of said . . . agent" in order to eliminate the redundancy as perceived by the Examiner and replaced that language with the term "wt %" referring to percentage as measured by weight. Thus a representative amendment reads as follows

> wherein said dispersing agent comprises from about 20 to about 70 wt % ~~percent by weight of said dispersing agent~~ based on the total weight of said dosage form.

In light of Applicants' amendment, it is respectfully requested the §112 ¶2 rejection be withdrawn.

§103(a) Rejection

Claims 2, 4 and 7-48 were rejected under "35 U.S.C. 103(a) as being unpatentable over WO 98/03064 to Sullivan." Applicants respectfully traverse said rejection. Examiner's obviousness rejection stands or falls on a single reference which is *non-analogous art* and is *improperly* cited against Applicants. Once Sullivan is removed, the Examiner's rejection must be withdrawn. Sullivan is a non-analogous art reference because it is not directed to Applicants' flashmelt pharmaceutical formulation designed to melt on the *tongue*, but is instead directed to a hardened tablet designed to disintegrate only after being *swallowed*. MPEP §2141.01(a) requires that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, *the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem* with which the inventor was concerned." Neither one of these criteria is satisfied by Sullivan. Moreover, the Examiner has not made provided any factual basis upon which one could conclude otherwise.

First, Sullivan is in the field of tablets that are meant to be swallowed. Applicants' invention is directed to flashmelt tablets, *i.e.*, formulations which are required to melt on the tongue with minimal moisture present without having to be chewed. Sullivan's own data attests to this. The only "rapid disintegration" Sullivan discloses is that which occurs in a *beaker*. No where in Sullivan is it taught or suggested that the formulations disclosed therein will rapidly dissolve on the tongue of a patient. Instead, Sullivan*'s* tablets are intended to be swallowed. This is supported by the fact that Sullivan is only able to assert that their formulations will disintegrate when *repeatedly agitated* after being placed in nearly a liter of water heated to 37 °C. (10:16-17) *See* USP 701 XXII Disintegration Test. In fact, if a tablet were to dissolve on the tongue when it was not intended to do so, it is very likely that the patient would spit the tablet out because of the bitter taste often associated with solid tablets containing pharmaceutical agents. This would result in significant compliance / efficacy problems with patients. Clearly, a swallowable tablet is in a different class from a rapid dissolve flashmelt tablet. Moreover, Sullivan *itself* defines its field distinct from Applicants. On page 2 lines 4-10, Sullivan states,

> [R]epresentative of earlier efforts in this field are, for example U.S. Patent 4,744,987 (Mehra et al), directed to a blend of microcrystalline cellulose (MCC) and calcium carbonate in pharmaceuticals; PCT publication WO 92/12633 (Mehra et al.), which discloses a combination of MCC and a nitrogenous compound; and Japanese Application 81/022,839 (Japan Metals and Chemical Co.) which employs a disintegrant comprising bentonite and an alkali metal silicate for agricultural formulations.

A review of these references will show that they are not in the field of pharmaceutical tablets intended to melt on the tongue. Thus, Sullivan is not in the same field as Applicants' invention.

Second, the "particular problems" to be solved between Sullivan and Applicants' invention are very different. Sullivan's goal is not simply to achieve more rapid disintegration, for that admittedly was accomplished by the more costly superdisintegrants discussed by Sullivan in the Background Section. *See* Sullivan 1:20-25. Sullivan's "problem" was reducing high cost solid tablets requiring expensive superdisintegrants to allow the tablet to disintegrate within a given time in the *stomach*. *See* Sullivan 2:15-30. The "problem" Applicants solved was creating a tablet that would melt on the *tongue* and furthermore such a tablet that could be made by direct compression. The problems solved by each invention are very different and thus the second criteria of MPEP §2141.01(a) is not satisfied either. Since neither of the criteria under MPEP §2141.01(a) can be satisfied, Sullivan cannot serve as §103 reference. Additionally, Applicants provide the attached Declaration of Mansoor A. Khan, R.Ph., Ph.D., affirming that the Sullivan reference is a non-analogous reference to the instant application. Applicants therefore respectfully request that the §103 rejection be withdrawn.[1]

Applicants respectfully wish to correct the Examiner's understanding of Sullivan's claimed ranges of co-disintegrants. The Examiner asserted that Sullivan taught calcium silicate in ranges

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[1] Applicants were unable to follow Examiner's response on page 6 paragraph 2 of the Final Rejection, i.e., "[i]n order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition." Applicants respectfully submit that Examiner's argument appeared to be misdirected to structurally similar substituents of organic chemical compounds under MPEP 2144.08(c) not pharmaceutical excipieints.

"from about 0.01 to 9.0 wt% preferably about 0.1 to 2.7 wt%." (3:6-7), whereas Applicants claims were directed to ranges from 20-70 %wt or more particularly 35-45 %wt which are well outside the ranges Sullivan teaches. The Examiner found this to be unpersuasive because Sullivan's claim 13 states "20 to 90 wt% of the super disintegrant is replaced by the co-disintegrant." Thus, the Examiner concluded that "the amount of calcium silicate included in Sullivan's formulation is actually much larger than 0.05 to 10% if portions of the superdisintegrant are replaced." Since Sullivan caps the total *combined* amount of superdisintigrants and co-disintegrants to 10% the maximum amount of co-disintegrant (Sullivan's diatomaceous silica) can be 9%, i.e., 90% of 10%, not 90% of the total unit dose as Examiner wrongly asserted. Moreover, Sullivan's examples reach only 3% diatomaceous silica not 9%. Thus, even if Sullivan were a properly cited reference, Applicants' claimed invention would not be rendered obvious by Sullivan's ranges.

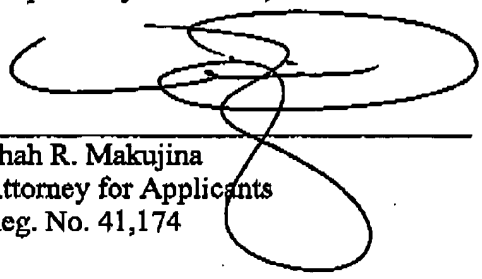
The Examiner took the position that "absent a showing of unexpected results, the use of a known active agent in a pharmaceutical composition is not patentable." Applicants cannot find any support for this position in the MPEP nor judicial precedent. Nor could one skilled in the art of pharmaceutical development understand that novel excipients or combinations thereof which overcome manufacturing and pharmacokinetic roadblocks be considered *per se* unpatentable. The Examiner continues with "[i]f the particular actives claimed by Applicant provide unexpected results in this type of formulation, it is suggested that these result *(sic)* be submitted in Declaration form." In the pharmaceutical industry, one does not have the liberty of picking and choosing the active ingredient merely to confer favorable manufacturing or pharmacokinetic properties to the dosage form. The active ingredient is in itself a separate discovery that now must be formulated in such a way that it can be mass manufactured and yet still retain the pharmacokinetic properties necessary to alleviate the ailment for which it was designed. Thus, it is *excipients* in various combinations and quantities that have to be discovered for any given active ingredient, not the converse. Nevertheless in an effort to understand the Examiner's invitation to submit a declaration in order to place the claims in condidtion for allowance, Applicants contacted the Examiner on three separate occasions. Three separate voicemails were left for the Examiner, February 3rd, 10th and 17th requesting clarification of the invitation to submit a declaration. None of these messages were returned. Applicants have nevertheless accepted Examiner's invitation to submit a declaration and have herein

submitted the Declaration of Mansoor A. Khan, R.Ph., Ph.D., affirming Applicants' position that Sullivan is a non-analogous art reference.

Applicants wish again to draw the Examiner's attention to Form 1449. The record indicates that the Examiner considered some but not all the references noted by Applicants. Specifically, in Applicants' IDS with USPTO stamp of January 17, 2002 under Foreign Patent Documents AK, AM, AN, AO were not considered as they were crossed out and uninitialed. AK refers to EP0890359 and was provided in English. AM, AN and AO are three Japanese patent applications for which English Abstract translations were provided. Applicants request that these references be considered and duly noted as such or in the alternative request clarification. In Applicants' Supplemental IDS with USPTO stamp of June 26, 2002 under Foreign Patent Documents AM, AN, AO, AP and AQ were not considered as they were crossed out and uninitialed. While translations for these Russian applications were not provided, the Russian Search report was provided pursuant to MPEP 609 III. A. A(3). Applicants request confirmation that these references were considered by the Examiner.

While Applicants submit that the claims are in condition for allowance and respectfully request the Examiner's reconsideration, a NOTICE OF APPEAL has nevertheless been filed.

Respectfully submitted,



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